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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,742	12/13/2001	Kishor P. Gadkaree	SP01-337	9693
22928	7590	12/29/2003		
CORNING INCORPORATED			EXAMINER	
SP-TI-3-1			GREENE, JASON M	
CORNING, NY 14831			ART UNIT	PAPER NUMBER
			1724	

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/020,742	GADKAREE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jason M. Greene	1724	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a)  The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  they raise the issue of new matter (see Note below);
  - (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3.  Applicant's reply has overcome the following rejection(s): The 35 U.S.C. 103(a) rejections of claims 7-35.
4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 10-35.

Claim(s) objected to: 7-9.

Claim(s) rejected: 1-6.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8.  The drawing correction filed on \_\_\_\_\_ is a) approved or b) disapproved by the Examiner.

9.  Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). \_\_\_\_\_.

10.  Other: \_\_\_\_\_

## **DETAILED ACTION**

1. The period for reply continues to run 3 MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

2. The shortened statutory period for reply expires THREE MONTHS from the mailing date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

3. The amendment filed 01 December 2003 under 37 CFR 1.116 in reply to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

**Allowed claim(s): 10-35**

**Rejected claim(s): 1-6**

**Claim(s) objected to: 7-9**

***Response to Arguments***

4. Applicant's arguments, see page 6, line 28 to page 7, line 9, filed 01 December 2003, with respect to claims 7-35 have been fully considered and are persuasive. The 35 U.S.C. 103(a) rejections of claims 7-35 have been withdrawn.

Specifically, the Examiner agrees with Applicants that Claussen and Cleveland teach high density ceramics that are specifically designed to have a high mechanical strength and very low porosity. Therefore, one of ordinary skill in the art would not have been motivated to use the ceramic materials disclosed by Claussen and Cleveland to form the porous filter structure of Gadkaree et al.

5. Claims 7-9 would be allowable if claim 7 were rewritten in independent form including all of the limitations of the base claim and any intervening claims because the prior art made of record does not teach the multicellular honeycomb structure of claim 1 wherein the ceramic material has an open porosity of at least 30% and a median pore size of at least 5 micrometers.

6. Applicant's arguments regarding claims 1-6 have been fully considered but they are not persuasive.

With regard to Applicants' arguments concerning the Gadkaree et al. reference, the Examiner agrees that Gadkaree et al. teaches cordierite and a mixture of cordierite and silicon carbide/silicon nitride being equally suitable materials for forming a multicellular honeycomb structure. However, the Examiner does not agree that such a disclosure teaches away from the present invention. While Gadkaree et al. admittedly does not recognize the advantages of using the specific percentages of cordierite and silicon carbide/silicon nitride disclosed by Applicants', the Examiner notes that Gadkaree et al. is only relied upon as teaching that a mixture of cordierite and silicon carbide/silicon nitride can be used to form a multicellular honeycomb body. The specific percentages of cordierite and silicon carbide/silicon nitride are disclosed in the Claussen and Cleveland references. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

With regard to Applicants' arguments concerning Claussen and Cleveland references, the Examiner agrees that Claussen and Cleveland are directed to high density ceramics having high mechanical strength and low porosity. However, the Examiner notes that claims 1-6 are directed only to a multicellular honeycomb structure comprising the specific mixture of cordierite and silicon carbide/silicon nitride. There is no recitation in the claims of the honeycomb structure being porous or having a specific porosity. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, while Gadkaree et al. is directed to a porous filter element, one of ordinary skill in the art would have recognized that the honeycomb structure of Gadkaree et al. could have been formed from a ceramic having a relatively low porosity and no end plugs to allow the honeycomb to function substantially as a catalyst support.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Greene whose telephone number is (571) 272-1157. The examiner can normally be reached on Monday - Friday (9:00 AM to 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone

number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0987.

Jason M. Greene  
Examiner  
Art Unit 1724



jmg  
December 17, 2003

DUANE SMITH  
PRIMARY EXAMINER

  
12-18-03